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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,369	12/10/2004	Francis Pinault	Q8-492	3960
23373 7590 02/19/2009 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER NICKERSON, JEFFREY L.	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/517,369

Applicant(s)

PINAULT ET AL.

Examiner

JEFFREY NICKERSON

Art Unit

2442

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2008 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. This communication is in response to Application No. 10/517,369 filed nationally on 10 December 2004 and internationally on 13 June 2003. The amendment presented on 10 December 2008, which provides change to claims 1, 9-12, 20-22, and provides replacement drawings, is hereby acknowledged. Claims 1-22 have been examined.

Drawings

2. The replacement drawings presented on 10 December 2008 are accepted. The objection to the drawings made under 37 CFR 1.84(o) is hereby withdrawn. The traversal of the objection under 37 CFR 1.83(a) has been considered and is deemed unpersuasive.

Applicant argues that the first and second transmission channels, and their characteristics throughout claim 1, do not be depicted in the figures because they "would not [be necessary] to understand the inventive aspects of the pending application". However, applicant's asserted novelty over the prior art, as found in claim 1, is to make data services available to a terminal during a voice connection, specifically by allowing data to be transmitted on a signaling channel while a voice connection is occurring on the bearer channel. Therefore, the identification of the channels, the setting up and/or tearing down of the channels, and the content of the channels with respect to the timing, are all paramount to understanding the claimed subject matter.

The objection to the drawings made under 37 CFR 1.83(a) is therefore maintained and recited again below.

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the first channel, second channel, voice data, configuration data, and voice connection must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. **The objection to the drawings will not be held in abeyance.**

Claim Objections

4. The amendment presented on 10 December 2008 providing change to various claims is noted. All prior objections are hereby withdrawn. However, new objections may appear below.

5. Claims 1-22 are objected to under 37 CFR 1.75 for generally failing to conform to US practice.

Regarding claims 1-22, these claims are missing an indefinite or definite article as the first word of each claim. Claims 1 and 12 contain two transitional phrases, neither of which clearly separates the preamble of the claim from the body of the claim (See MPEP 2111.03). "Adapted to" language is generally discouraged as it can lead to ambiguity and applicant should positively recite the functionality of the structural components with, for instance and when necessary, "that" or "for" (if applicant wishes to invoke 112 sixth; See MPEP 2111.04). Any reference characters in the claims are generally discouraged as it is unclear whether the claimed element must contain all the features of the referenced element found in the drawing. Claims 1 and 12 are generally narrative and the preamble is unidentifiable which creates ambiguity as to which recitations within the claim are a mere intended use or actual limitations (See MPEP 2111.03). Each element of the server should be separated by a line of

indentation and further indentations are suggested for segregating related sub-elements. See 37 CFR 1.75(e)-(i).

Response to Arguments

6. Applicant's arguments filed 10 December 2008 have been fully considered but are deemed not persuasive.

Independent claims 1 and 12

Applicant argues the combined teachings of Mani (US 2002/0188725 A1), Clark (US 5,490,251) and Katinakis (US 6,389,039 B1) do not teach a limitation. Specifically, applicant argues the combined teachings do not teach the following:

"so as to make at least some of said services offered by said second network available to said terminal during said voice connection".

The examiner respectfully disagrees. Katinakis teaches interleaving data onto a bearer channel while a voice connection is active, during the times in which the speaker is not talking (Katinakis: col 5, lines 16-22). Katinakis therefore provides for making at least some of said services offered available to said terminal during said voice connection. Mani teaches wherein the services offered are by said second network (Mani: abstract, Figure 3). Therefore, the combined teachings provide for making at least some of the said services offered by said second network available to said terminal during said voice connection. Thus, the rejections of these claims are hereby maintained.

Dependent claims 4 and 15

Applicant argues the combined teachings of Mani, Clark, and Katinakis do not teach a limitation. Specifically, applicant argues that the combined teachings fail to teach the following:

"[wherein] control means send identification data to said terminal"; and
"wherein the identification data, once installed in said terminal, enables the automatic sending to said server at least one secondary identifier stored in the memory of said terminal".

The examiner respectfully disagrees. Mani teaches that an access application server and/or multimedia softswitch can trigger a network access application (Mani: Figure 6A, step 604; [0040]), hosted on a centralized server or distributed across multiple devices or a third party provider (Mani: [0040]), to interrogate the user's device for credentials (Mani: Figure 6A, step 606; [0041]). The user's device may then actively or passively query the user multiple times and send multiple responses back to the access server (Mani: Figure 6A, steps 606 – 608; [0041]-[0042]). Therefore, the combined teaches provide for wherein control means send identification data to said terminal and wherein the identification date, once installed in said terminal, enables sending to said server at least one secondary identifier stored in the memory of said terminal. Thus, the rejections of these claims are hereby maintained.

Dependent claims 5 and 16

Applicant argues that the combined teachings of Mani, Clark, and Katinakis do not teach a limitation. Specifically applicant argues that the combined teachings do not security data as disclosed by applicant's specification.

The examiner respectfully disagrees. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., security data being a "calculated authentication key") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Thus, the rejections of these claims are hereby maintained.

Dependent claims 10 and 21

Applicant argues that the combined teachings of Mani, Clark, and Katinakis do not teach a limitation. Specifically applicant argues that the combined teachings do not the following limitation:

"in the event of an attempt by said terminal to call a remote terminal ... inhibiting access"

Applicant asserts this limitation is not taught because a "call" to a remote resource is not the same as an "access attempt" to a remote resource.

The examiner respectfully disagrees. The examiner has found no definition for the term "call" within the claim language or applicant's specification. Applicant illogically assumes a "call" is limited to a connection-oriented data path that transfers real-time voice data. The examiner respectfully disagrees with this assumption, as the term "call" has various interpretations, many of which would be reasonable by a person having ordinary skill in the art upon reading, and consistent with, applicant's specification, including interpreting a "call" as an "access attempt". Thus, the rejections of these claims are hereby maintained.

Dependent claims 2-3, 6-9, 11, 13-14, 17-20 and 22

Applicant argues these claims conditionally on the arguments of their parent claims.

Therefore, the rejections of these claims are hereby maintained.

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
8. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mani (US 2002/0188725 A1), and in further view of Clark (US 5,490,251) and Katinakis et al (US 6,389,039 B1).

Regarding claim 1, Mani teaches a communication server for making services offered by a private second communication network available to terminals connected to a first communication network (Mani: abstract; [0032]), the server comprising:

control means that sends configuration data to a terminal connected to the first network as a function of a selected criterion (Mani: abstract; Figure 3; [0021]-[0023]);

wherein the configuration data enables said terminal to setup a connection with said server, so as to make at least some of said services offered by said second network available to said terminal (Mani: abstract; Figure 3; [0021]-[0023]); and

wherein the server is able to exchange signaling data on a first transmission channel and voice data on a second transmission channel simultaneously in accordance with a selected protocol (Mani: Figure 5, items 514, 508, 502; [0032]; Figure 1, item 104; See also [0008]).

Mani does not teach sending configuration data on the first channel during a voice connection between at least two users on said second channel so as to make services available during said voice connection.

Clark, in a similar field of endeavor, teaches sending configuration data on the first channel (Clark: abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Clark for sending data over a signaling channel. The teachings of Clark, when implemented in the Mani system, will allow one of ordinary skill in the art to authenticate users over a signaling channel instead of the

bearer channel. One of ordinary skill in the art would be motivated to utilize the teachings of Clark in the Mani system in order to conserve network resources.

The Mani/Clark system does not teach wherein data on another channel is being sent during a voice connection between at least two users on said second channel so as to make services available during said voice connection.

Katinakis, in a similar field of endeavor, teaches wherein data on another channel is being sent during a voice connection between at least two users on said second channel, so as to make services available during said voice connection (Katinakis: abstract, col 5, lines 16-22).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Katinakis for simultaneous voice and data transmissions. The teachings of Katinakis, when implemented in the Mani/Clark system, will allow one of ordinary skill in the art to send authentication data over a signaling channel while a voice connection is using the main bearer channel. One of ordinary skill in the art would be motivated to utilize the teachings of Katinakis in the Mani/Clark system in order to allow users to access both voice and data services simultaneously.

Regarding claim 2, the Mani/Clark/Katinakis system teaches wherein the control means send configuration data to a terminal when said terminal has set up a connection with said server using a selected primary identifier, setting up said connection constituting said selected criterion (Mani: [0021] and [0012]).

Regarding claim 3, the Mani/Clark/Katinakis teaches wherein said control means effect an identification procedure before sending said configuration data (Mani: [0012]).

Regarding claim 4, the Mani/Clark/Katinakis system teaches wherein the server further comprises:

a memory (database) in which secondary identifiers are stored (Mani: [0012] provides for storing user access profiles; [0010] provides the access profile can hold more than one identifier to verify against);

wherein the control means send identification data to said terminal (Mani: Figure 6A, step 604; [0040]);

wherein the identification data, once installed in said terminal, enables the automatic sending to said server at least one secondary identifier stored in a memory of said terminal (Mani: Figure 6A, steps 606 – 608; [0041]-[0042]; and

wherein the control means compares the received secondary identifier with identifiers stored in said memory and then to send said configuration data to said terminal if the identifiers are identical (Mani: [0012]).

Regarding claim 5, the Mani/Clark/Katinakis system teaches wherein said control means sends security data (interrogation) to the terminal after said configuration data (Mani: [0044] specifies that interrogations can occur after the network resource is being accessed).

Regarding claim 6, the Mani/Clark/Katinakis system teaches wherein said secondary identifier represents the user of said terminal (Mani: [0012] specifies live picture IDs and speech samples).

Regarding claim 7, the Mani/Clark/Katinakis system teaches wherein said configuration data or said identification data constitutes a script or an applet (Mani: [0040]-[0042]).

Regarding claim 8, the Mani/Clark/Katinakis system teaches wherein said configuration data, in the event of activation by the user of the terminal (Mani: abstract provides the user can indicate) prompts (queries) said user to provide at least one tertiary identifier and to send a registration request (access attempt) containing at least said tertiary identifier to said control means (Mani: [0039] specifies different types of authentication techniques) on the first channel (Clark: abstract);

wherein memory stores said primary identifiers in corresponding relationship to at least one tertiary identifier, and in that said control means, on the receipt of a registration request, send to said configuration data a request for the transmission of at least one primary identifier associated with said terminal, and then, on reception of said primary identifier, compare the primary identifier and the tertiary identifier previously received to the identifiers stored in said memory in order to authorize or refuse said registration as a function of the result of this comparison (Mani: [0037]-[0042] specify a database cluster that holds profile information with multiple identifiers and the possibility

of cascading interrogation to receive multiple levels of authentication, where the database server could be available to both the private and public networks and the interrogation responses are verified against the user access profiles).

Regarding claim 9, the Mani/Clark/Katinakis system teaches wherein said configuration data, in the event of reception of a call request message from the first network by said terminal (Clark: col 6, lines 35-50), extracts certain information from said message and sends that information to said control means via said first channel (Katinakis: abstract and col 5, lines 16-22 provide for bidirectional communication of any data over signaling); and

wherein said control means, on receipt of said information, processes it as a function of its content and then sends to said terminal on said first channel a message selected as a function of the processing applied and the information received (Clark: col 6, lines 56-65).

Regarding claim 10, the Mani/Clark/Katinakis system teaches wherein said configuration data, after the terminal has been registered and in the event of an attempt by said terminal to call a remote terminal (Mani: [0010], [0042]; Clark: col 6, lines 9-20), inhibits access to the first network and sends information including at least the primary identifier of the remote terminal to said control means on said first channel (Clark: col 6, lines 56-65);

wherein said control means, on receipt of said information, processes it as a function of its content (Mani: [0042]) and sends to said terminal on said first channel a message selected as a function of the processing applied and the information received; and comprising at least one call authorization or prohibition (Mani: [0042]); and

wherein the information is to be displayed on the screen of said terminal (Mani: [0008], [0020]), so that on reception of said message, said configuration data either removes the inhibition on access to the first network with a view to setting up the call or prohibits the call (Mani: [0042]).

Regarding claim 11, this server claim comprises limitations found within claim 9 and the same rationale of rejection is used, where applicable; and

wherein said control means process the information received from said terminal after registering the terminal (Mani: [0044] specifies that additional interrogation and processing of those interrogations may occur after the original access is granted).

Regarding claim 12, this method claim comprises limitations corresponding to that of claim 1 and the same rationale of rejection is used, where applicable.

Regarding claim 13, this method claim comprises limitations corresponding to that of claim 2 and the same rationale of rejection is used, where applicable.

Regarding claim 14, this method claim comprises limitations corresponding to that of claim 3 and the same rationale of rejection is used, where applicable.

Regarding claim 15, this method claim comprises limitations corresponding to that of claim 4 and the same rationale of rejection is used, where applicable.

Regarding claim 16, this method claim comprises limitations corresponding to that of claim 5 and the same rationale of rejection is used, where applicable.

Regarding claim 17, this method claim comprises limitations corresponding to that of claim 6 and the same rationale of rejection is used, where applicable.

Regarding claim 18, this method claim comprises limitations corresponding to that of claim 7 and the same rationale of rejection is used, where applicable.

Regarding claim 19, this method claim comprises limitations corresponding to that of claim 8 and the same rationale of rejection is used, where applicable.

Regarding claim 20, this method claim comprises limitations corresponding to that of claim 9 and the same rationale of rejection is used, where applicable.

Regarding claim 21, this method claim comprises limitations corresponding to that of claim 10 and the same rationale of rejection is used, where applicable.

Regarding claim 22, this method claim comprises limitations corresponding to that of claim 11 and the same rationale of rejection is used, where applicable.

Citation of Pertinent Prior Art

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
 - a. Belcea (US 7,266,104 B2) discloses a system wherein a user terminal is capable of simultaneous voice and data services.
 - b. Hsu et al (US 7,369,529 B2) discloses a system wherein a user terminal is capable of simultaneous voice and data services.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFREY NICKERSON whose telephone number is (571)270-3631. The examiner can normally be reached on M-Th, 8:30-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. N./
Jeffrey Nickerson
Examiner, Art Unit 2442

/Andrew Caldwell/
Supervisory Patent Examiner, Art
Unit 2442